

I. Substance of the Examiner Interview

During the Examiner interview held on July 29, 2008, at 11:30am in the Office of Examiner Celia C. Chang, Art Unit 1625, Mr. Clifford M. Davidson began by presenting an overview of the prosecution history of the present application to Examiner Chang that included mention of the following:

- i) Restriction Requirement mailed on April 11, 2007 and Applicants Response submitted on June 11, 2007 by the previous agent of record Finnegan, Henderson, Farabow, Garrett & Dunner, LLP;
- ii) Non-final Office Action mailed August 28, 2007 and Applicants Amendment submitted on December 26, 2007 also by Finnegan, Henderson, Farabow, Garrett & Dunner, LLP;
- iii) Supplemental Amendment submitted on January 31, 2008 by current agent of record, Davidson, Davidson & Kappel, LLC;
- iv) Supplemental Information Disclosure Statement submitted March 28, 2008, by Davidson, Davidson & Kappel, LLC; and
- v) Final Office Action mailed March 31, 2008, and subsequent Amendment after final and Supplemental Information Disclosure Statement submitted on June 25, 2008, by Davidson, Davidson & Kappel, LLC.

With regard to the Amendment after final, Mr. Davidson first addressed the Examiner's rejection of claims 5-17 under 35 U.S.C. § 102(e), (f) or (g) over U.S. 2004/0077697. Mr. Davidson explained the scope of the proviso recited in claim 5, which states:

“(...when R³ is aryl or pyridyl, each of which can be substituted with one or more groups selected from the group consisting of lower alkyl, -CO-lower alkyl, -COO-lower alkyl, -OH, -O-lower alkyl, -OCO-lower alkyl, and halogen, then Ar² is not phenyl or pyridyl, each of which can be substituted with one or more groups selected from the group consisting of lower alkyl, -CO-lower alkyl, -COO-lower alkyl, -OH, -O-lower alkyl, -OCO-lower alkyl, and halogen),...”

and explained why, with the inclusion of the proviso, the compounds encompassed by the genus claimed in independent claim 5 are not and cannot be the same as the compounds disclosed in the Koshio, et al. reference (US 2004/0077697) cited by the Examiner (See: Office Action, page 3, item #4). Mr. Davidson's explanation is outlined in further detail starting on page 27, section D of this submission.

In view of Mr. Davidson's explanation, the Examiner indicated her understanding for the “proviso” language and was in agreement that claim 5 was now demarcated and clear.

Further to the above, Mr. Davidson also explained to the Examiner that the word “then” contained in present claim 5 was added to claim 5 by way of the Supplemental Amendment submitted to the Patent Office on January 31, 2008. However, it was explained that at the time of the submission of the Supplemental Amendment, the amended claim did not contain the proper underline identifier to indicate that this word was added. Therefore, Applicant will resubmit in the present amendment amended claim 5 so that all deletions and insertions are properly identified.

Next, Mr. Davidson addressed the Examiner's rejection of claims 5-11 under 35 U.S.C. § 102(a) over Muto, et al. (WO 02/049632). In particular, Mr. Davidson explained to the Examiner where in the priority documents support can be found for elements R²⁰, R²¹, R²², R²³, R²⁶, R²⁷, or R²⁸, and further explained why the scope of these elements are consistent with the definition of the elements found in the priority documents as R³⁻⁶, R⁹, R¹⁰ and R¹¹, thus providing proper evidence for Applicant's claim of priority.

The Examiner explained that her issue is not with the scope of the elements being the same, but rather the elements not being "identical". The Examiner explained that her responsibility is to show that the priority documents and the present application (PCT specification) are "identical". Because the priority documents recite different elements than the present claims, regardless of whether the scope of the elements are the same, the Examiner indicated that she cannot say they are identical. To overcome this rejection, the Examiner suggested that Applicants submit a Rule 1.132 Affidavit (Affidavit or declarations traversing rejections or objections) that attests to the fact that while the numerical representations of the Markush elements contained in the present specification were changed in relation to the numerical representations of the Markush elements contained in the priority documents, within the context of 35 U.S.C. § 119 (benefit of earlier filing date; right of priority), the claims of the present invention are supported by and entitled to priority to both Japanese priority documents. The Examiner is directed to the Affidavit of Mr. Tetsuya Kimizuka submitted herewith and Applicant's explanation in Section C(3) of this amendment.

Mr. Davidson then addressed the Examiner's indefiniteness rejections of claims 5 and 37 under 35 U.S.C. § 112, second paragraph. First Mr. Davidson reiterated his explanation of claim 5 as mentioned above and further explained that claim 37 is narrower in scope than claim 5 because the substituent R³ recited in claim 37 is limited to a substituted or unsubstituted thienyl, and claim 37 therefore does not require the recitation of the proviso recited in claim 5.

The Examiner indicated her understanding that claim 37 is independent and not the same as claim 5, that antecedent basis was described, and that the more limited scope of claim 37 is still within the election made by Applicant in the response to restriction requirement submitted by Applicant on July 11, 2007 to the U.S. Patent Office.

Mr. Davidson then explained that claim 13 was amended in the present amendment, but that the heading of "previously presented" was a typographical error that would be corrected to recite "currently amended" with the next submission.

With regard to the above explanations, the Examiner further indicated that while Applicants' future submissions may clear the 102(a) anticipation and the 102(e), (f) or (g) issues, the Examiner may have to issue a new rejection based on a 35 U.S.C. § 102(a) obviousness-type double patenting, unless Applicants submission contains a statement indicating that US 2004/0077697 is abandoned and that no continuation applications have been filed.

Before the end of the interview, Examiner Chang indicated that an Examiner Interview Summary with Advisory Action would be issued. The Examiner further indicated that while Applicants may chose to petition to remove the finality of the present Office Action, it would be "better" if the Applicants file a Request for Continued Examination (RCE) together with the Rule 1.132 Affidavit.

Before concluding the interview, Examiner Chang prepared an Interview Summary that was initialed by Mr. Davidson, Mr. Zanzalari and Mr. Hamilton. The Interview Summary indicated that claims 5, 7, 9-13 and 18-47 were discussed and that agreement with respect to the claims was not applicable and that "the extensive merit evaluation will be made in a continuous filing."